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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,269	03/05/2002	Tadahiro Ohmi	FUK-84	2418
22855	7590	03/07/2005	EXAMINER	
RANDALL J. KNUTH P.C. 4921 DESOTO DRIVE FORT WAYNE, IN 46815			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 03/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/889,269

Applicant(s)

OHMI ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 1/10/05 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

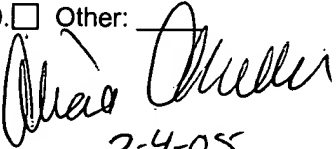
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1 and 2.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other:  3-4-05

### Continuation Sheet

Continuation of 5. because: It remains the Examiner's position that the claims are unpatentable for reasons previously of record in the final office action, mailed February 9, 2004.

#### *Response to Applicant's Arguments*

1. Applicant's arguments in the response filed January 10, 2005 regarding the 35 U.S.C. 102 rejection over Ohmi (U.S. Patent No. 5,656,099) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that not only are the processes different between, but the respective end products of the invention and Ohmi are different. Applicant essentially argues that the chromium oxide layer of Ohmi does not meet the limitation "chromium coat" in instant claim 1. It also appears that Applicant believes that the limitation "chromium coat" adds additional structure to final product.

Claim 1 recites, "Metallic material provided with a chromium-oxide passivation film comprising a passivation film consisting of *chromium oxide obtained by a chromium coat on the metallic material* of which surface roughness (Ra) is not more than 1.5  $\mu\text{m}$ ."

Applicant's argument seems to be that the reference does not disclose the *intermediate processing step* of coating chromium on to the metallic material and then oxide. As stated before the limitation "obtained by a chromium coat on the metallic material" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of

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patentability of the product itself, unless Applicant presents *evidence* from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Ohmi does disclose an oxidized chromium coat on the metallic material (*column 2, lines 33-45*). Also, it is further noted that chromium oxide is always made from chromium whether coated on a metallic material or not.

It is noted that Applicant is claiming a *final product* with a chromium-oxide layer and a metallic material with a specific surface roughness, NOT the intermediate product, i.e. a chromium coat on a metallic material, from the intermediate processing step.

Furthermore, it is unclear how the “chromium coat” of the intermediate processing step results in a *structural difference* between the claimed invention and the prior art.

2. Applicant’s arguments in January 10, 2005 regarding the 35 U.S.C. 103 rejection over Uchida (U.S. Patent No. 4,248,676) in view of Ohmi of record have been carefully considered but are deemed unpersuasive.

In response to Applicant’s argument that there is no suggestion to combine reference, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole suggests to one of ordinary skill in the art.

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Furthermore, the motivation for to make the modification is expressly stated in Ohmi, i.e. because of the improved corrosion resistance gained by layer consisting only of chromium oxide (*Ohmi col. 2, lines 24-38*). Therefore, it would have been obvious to one of ordinary skill in the art to use a chromium oxide as the passivation film in Uchida as taught by Ohmi because of the improved corrosion resistance gained by layer consisting only of chromium oxide.

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of *evidence* in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier

3/4/05